

**Application No. 10/061458**  
**Page 8**

**Response After Final**  
**Attorney Docket No. S63.2L-10389-US01**

### **Remarks**

This paper is filed in response to the Final Office Action dated **March 8, 2006**. Claims 1-37 are pending in this application. The Office Action rejected claims 34-37 under 35 USC § 112, first paragraph; rejected claims 28-37 under 35 USC § 102 over Berry et al. (US 6231598; hereinafter "Berry"); and allowed claims 1-27.

Reconsideration in view of the following remarks is respectfully requested.

### **Allowable Subject Matter**

Applicants acknowledge the Office Action's indication of allowable subject matter in claims 1-27. However, for the reasons set forth below, Applicants respectfully assert that all of the claims are directed to allowable subject matter and that the application is in condition for allowance.

### **Claim Rejections - 35 USC § 112**

The Final Office Action maintains the rejection of claims 34-37 under 35 USC § 112, first paragraph. This rejection is traversed. In the Amendment filed November 21, 2005, Applicants asserted reasons why this rejection was traversed and provided a marked excerpt of Figure 2A in support of their position. The immediate Final Office Action maintained the rejection but did not comment on Applicants' rebuttal arguments as required by the § 112 examination guidelines set forth in MPEP § 2163, subsection III B.

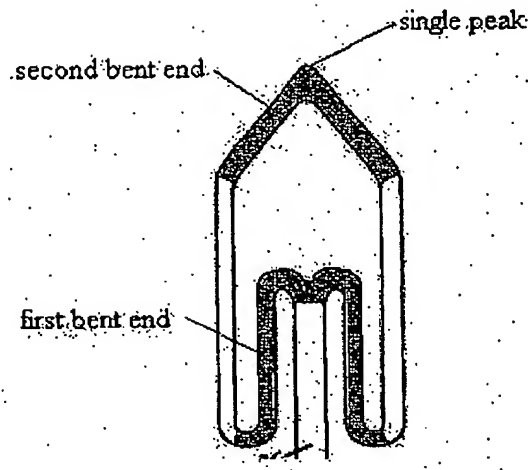
The Final Office Action alleges that a second bent end having a single peak was not disclosed in the specification. See page 2.

Applicants have provided an excerpt from Figure 2A below, marked to clearly show the second bent end having a single peak. Applicants assert that Figure 2A clearly provides the support for independent claim 34 required under 35 USC § 112.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See *Moba, B.V. v. Diamond Automation, Inc.*, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003).

Application No. 10/061458  
Page 9

Response After Final  
Attorney Docket No. S63.2L-10389-US01



Excerpt from Fig. 2A

A person of ordinary skill in the art, viewing Figure 2A, would conclude that the Applicants clearly had possession of a cell for use in a stent according to independent claim 34.

Drawings alone may provide a 'written description' of an invention as required by 35 USC § 112. See *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

In this case, Figure 2A is an original drawing that is a part of the specification and thus provides the support required by 35 USC § 112.

If a complete structure is disclosed, the written description requirement is satisfied for that species or embodiment, and a rejection under 35 USC § 112, first paragraph, for lack of written description must not be made. See MPEP § 2163.

Figure 2A clearly discloses the complete structure as defined by independent claim 34. Therefore, the written description requirement is satisfied for independent claim 34. Because the Office Action did not comment on dependent claims 35-37, Applicants assume that the dependent claims were included in the rejection simply for being dependent upon rejected claim 34. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 112, first paragraph.

#### Content of Berry (US 6231598)

At least a portion of the subject matter disclosed in Berry is not prior art to the

**Application No. 10/061458**  
**Page 10**

**Response After Final**  
**Attorney Docket No. S63.2L-10389-US01**

immediate application.

The immediate application is a Reissue Application of US 6019789, which was filed April 1, 1998.

Berry claims priority to two provisional applications: 1) US Provisional Application No. 60/082164, filed April 17, 1998; and 2) US Provisional Application No. 60/059898, filed September 24, 1997.

The immediate application claims priority to a filing date that is earlier than the filing date of the '164 provisional application. Without conceding that any content of the '898 provisional application is prior art, Applicants assert that any subject matter included in Berry that was not included in the '898 provisional application is clearly not prior art to the immediate application.

In the event that further rejections are made over Berry, Applicants request that the Examiner verify that the contents of Berry relied upon are clearly disclosed in the '898 provisional application.

**Claim Rejections – 35 USC § 102 (Independent claim 28)**

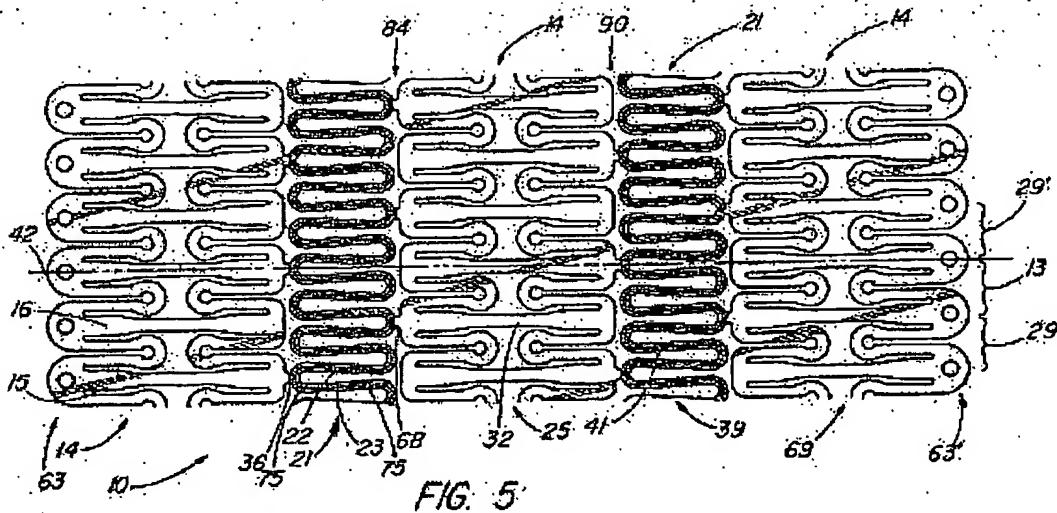
The Final Office Action rejected claims 28-33 under 35 USC § 102 over Berry. These rejections are traversed. The Final Office Action did not discuss the limitations added by the Amendment filed November 21, 2005, and further did not provide any explanation of why the added limitations failed to overcome the previous rejection over Berry.

Claim 28 recites a “stent comprising a plurality of circumferential serpentine bands including first circumferential serpentine bands and second circumferential serpentine bands, the first circumferential serpentine bands having a width in excess of the width of the second circumferential serpentine bands...”

The Office Action refers to Figure 5 of Berry, shown below, and asserts that Berry discloses “first serpentine circumferential bands (14) and second serpentine circumferential bands (21).” See Office Action pages 2-3. The “second” bands (21) as asserted in the Office Action have been shaded below.

Application No. 10/061458  
Page 11

Response After Final  
Attorney Docket No. S63.2L-10389-US01



Claim 28 further recites “at least one second serpentine circumferential band immediately adjacent to and connected to another second serpentine circumferential band by a longitudinal connector” (emphasis added).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants assert that Berry does not disclose or suggest a “second” serpentine circumferential band immediately adjacent to another “second” serpentine circumferential band. As shown in Figure 5, two “first” bands (14) are oriented between the two “second” bands (21). Thus, each “second” band (21) is immediately adjacent to a “first” band (14), and not immediately adjacent to another “second” band (21) as required by claim 28.

Applicants further assert that Berry does not disclose or suggest a “second” band connected to another “second” band by a longitudinal connector. Even under a broad interpretation of Berry, wherein the connectors (32) might be described as extending past the “first” bands (14) and connecting to a “second” band (21), thus encompassing interconnection struts (36 or 68), each connector (32) would only attach to a single “second” band (21). No connector (32) attaches between two “second” bands (21). Therefore, Berry does not disclose or suggest all of the limitations of claim 28, and claim 28 is patentable over Berry.

Claims 29-33 depend from independent claim 28 and are therefore patentable for

*Application No. 10/061458*  
*Page 12*

*Response After Final*  
*Attorney Docket No. S63.2L-10389-US01*

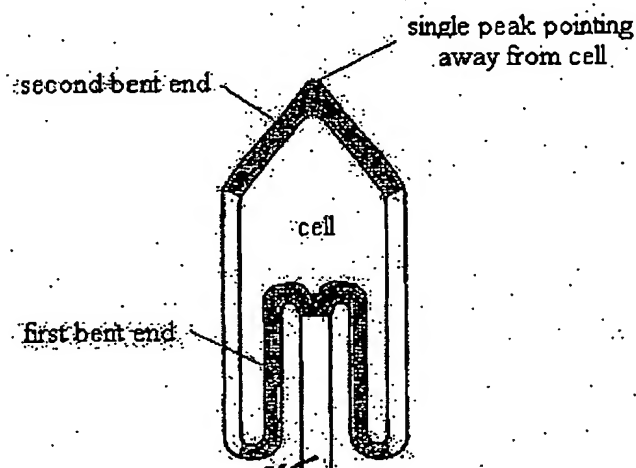
at least the reasons discussed with respect to claim 28. Accordingly, Applicants request the withdrawal of the rejections of claims 28-33 under 35 USC § 102.

**Claim Rejections – 35 USC § 102 (Independent claim 34)**

The Final Office Action rejected claims 34-37 under 35 USC § 102 over Berry. These rejections are traversed.

Independent claim 34 has been rejected over Berry multiple times. In each rejection, the Office Action made a conclusory statement that claim 34 was unpatentable but provided absolutely no guidance as to the specific portions of Berry that allegedly corresponded to the limitations of claim 34. The immediate Final Office Action again rejected claim 34 over Berry with no discussion, and further failed to provide any explanation of why the limitations added by the Amendment filed November 21, 2005 failed to overcome the rejection.

Claim 34 recites a cell “comprising a first bent end characterized by a first width and a second bent end characterized by a second width different from the first width.” Claim 34 further requires the first bent end to have “a peak oriented in a first direction” and the second bent end to have “a single peak, the single peak oriented in the first direction and pointing away from the cell.” An excerpt from Figure 2A illustrating a portion of the limitations of claim 34 is provided below.



Excerpt from Fig. 2A

Application No. 10/061458  
Page 13

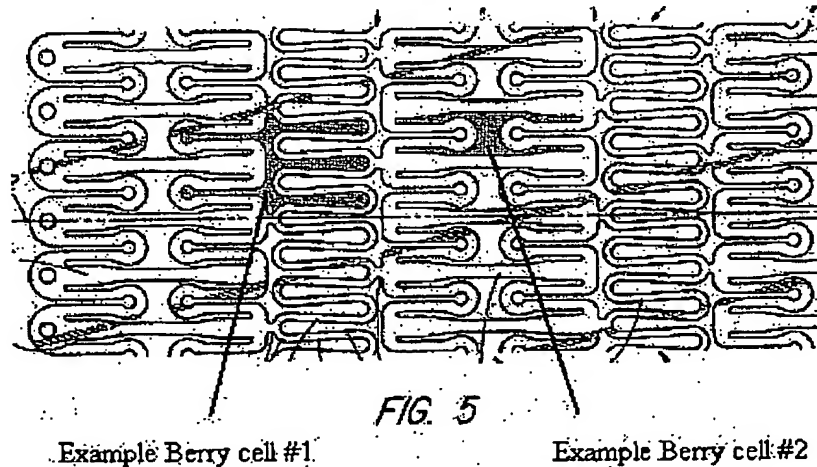
Response After Final  
Attorney Docket No. S63.2L-10389-US01

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Any content of Berry relied upon must have been disclosed in US Provisional Application No. 60/059898, filed September 24, 1997. See previous section entitled Content of Berry.

Applicants assert that Berry does not disclose or suggest a cell having the claimed "first bent end" having "a peak oriented in a first direction" and the claimed "second bent end" having "a single peak, the single peak oriented in the first direction and pointing away from the cell."

Due to the fact that Office Action failed to provide guidance as to the specific content of Berry, Applicants have labeled possible "cells" below.



In Example Berry cell #1, no "bent end" of the cell has a single peak. To the extent that the "bent end" located on the left side of cell #1 could be described as having a single peak, the alleged single peak would not point "away from the cell" as required by claim 34. Therefore, Applicants assert that Example Berry cell #1 does not render claim 34 unpatentable.

In Example Berry cell #2, the "bent ends" of the cell point towards each other, and therefore point in opposite directions. Thus, once a "bent end" was labeled the "first bent end" having "a peak oriented in a first direction," the other "bent end" would not also point in the "first direction" as required by claim 34. Therefore, Applicants assert that Example Berry cell #2

*Application No. 10/061458*  
*Page 14*

*Response After Final*  
*Attorney Docket No. S63.2L-10389-US01*

does not render claim 34 unpatentable.

Other possible "cell" shapes disclosed in the Figures of Berry are either: 1) substantially similar in configuration to Example Berry cells 1 & 2 above; 2) less pertinent to claim 34 than Example Berry cells 1 & 2 above; or 3) not disclosed in US Provisional Application No. 60/059898, and thus cannot be cited as prior art to the immediate application.

Therefore, Applicants assert that independent claim 34 is patentable over Berry. Claims 35-37 depend from independent claim 34 and are therefore patentable for at least the reasons discussed with respect to claim 34. Accordingly, Applicants request the withdrawal of the rejections of claims 34-37 under 35 USC § 102.

#### **Non-Final Office Action Request**

The guidelines for examination under 35 USC § 112 set forth in MPEP § 2163, subsection III B require an Examiner to explain reasons why rebuttal arguments filed by an Applicant in response to a § 112, first paragraph rejection are not persuasive. The Final Office Action maintained a rejection under 35 USC § 112 without explaining reasons why the rebuttal arguments filed by Applicants on November 21, 2005 were not persuasive.

The Final Office Action maintained the rejection of claims 28-33 under 35 USC § 102 without any explanation of why the limitations added to claim 28 by the Amendment filed November 21, 2005 failed to overcome the rejections. The limitations added by the Amendment were not discussed. The final rejection simply reproduced a portion of the Examiner's arguments presented in the previous Non-Final Office Action dated August 30, 2005.

The Final Office Action rejected claims 34-37 with absolutely no explanation of the particular portions of Berry that were relied upon in making the rejections. Further, none of the previous Office Actions provided any specific guidance as to which portions of Berry were believed to render claim 34 unpatentable. The Final Office Action maintained the rejection of claims 34-37 without any explanation of why the limitations added to claim 34 by the Amendment filed November 21, 2005 failed to overcome the rejections. The limitations added by the Amendment were not discussed, and the Office Action was silent as to all of the limitations of claim 34.

"When a reference is complex or shows or describes inventions other than that

*Application No. 10/061458*  
*Page 15*

*Response After Final*  
*Attorney Docket No. S63.2L-10389-US01*

claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.104(c)(2) (emphasis added).

In light of the above remarks, Applicants request that if the immediate application is not allowed, a subsequent Non-Final Office Action be presented, along with specific explanations of why the claims are rejected. Applicants request that such explanations go beyond the statements made in previous Office Actions.

#### **Alternative Interview Request**

Applicants' undersigned representative left a voicemail message for the Examiner requesting a telephonic interview in an attempt to avoid this Response After Final. The call was not returned.

In the event that the Examiner refuses to issue a Non-Final Office Action as requested above, Applicants request that the Examiner contact Applicants' undersigned representative to discuss the content of the prior art before issuing an Advisory Action.



*Application No. 10/061458*  
*Page 16*

*Response After Final*  
*Attorney Docket No. S63.2L-10389-US01*

**Conclusion**

Based on at least the foregoing remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: May 8, 2006

By: \_\_\_\_\_

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